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|--|-------------|----------------------|---------------------------|------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
| 10/534,524   | 01/04/2006  | Tetsuji Kito         | 271771US0PCT              | 5201             |
| 22850  | 7590        | 12/05/2008           |                           |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>NATHAN, SHYAM |                  |
|  |             |                      | ART UNIT                  | PAPER NUMBER     |
|  |             |                      | 1611                      |                  |
|  |             |                      | NOTIFICATION DATE         | DELIVERY MODE    |
|  |             |                      | 12/05/2008                | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/534,524 | <b>Applicant(s)</b><br>KITO ET AL. |  |
|                              | <b>Examiner</b><br>SHYAM NATHAN      | <b>Art Unit</b><br>1611            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/11/2005,08/11/2005,10/10/2008.

### **DETAILED ACTION**

Claims 1-9 are pending in the instant application. This is the first Office Action on the merits of the claims.

#### ***Priority***

The earliest effective US filing date afforded the instantly claimed invention is 11/113/2003, the filing date of application PCT/JP03 /144448.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Daisuka et al (EP 1036553 A2; issued 09/20/2000).

Instant claim 1 is drawn to an emulsified cosmetic composition comprising surface-hydrophobated water-absorbing polymer particles and water.

Daisuka teaches of a solid water in oil type emulsion cosmetic composition which contains a hydrophobically treated powder and spherical silica , which is a surface-hydrophobated water-absorbing polymer particles, and water. [0003-0005]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daisuka et al (EP 1036553 A2; issued 09/20/2000) and Nambu et al (EP 1258290; issued 1/20/2002).

Instant claims 2-9 are drawn to a emulsified cosmetic composition according to claim 1, wherein the average particle diameter of the surface-hydrophobated water-absorbing polymer particles is 0.1 to 50  $\mu\text{m}$ , wherein the amount of water absorbed into the surface-hydrophobated water-absorbing polymer particles is 5 to 100 g/g, has a viscosity of 1,000 to 500,000 mPa·s, wherein the content of water is 30 to 95% by weight, and is an antiperspirant or a method of antiperspiration.

Daisuka teaches of a solid water in oil type emulsion cosmetic composition which contains a hydrophobically treated powder and spherical silica, which is a surface-

Art Unit: 1611

hydrophobated water-absorbing polymer particles, and water. [0003-0005], Wherein the content of the oil to the water is 0.5 to 10 [0005], which meets the criteria that the content of the water is 30-95% by weight of the composition. But Daisuka does not teach of a silicone-modified water –absorbing polymer particle.

Nambu teaches of a wherein silicone can be stably present on the surface of the water absorbing polymer particle wherein the silicone compound has at least one functional group[0005-0007], the average diameter of the particles is preferably 1-50 Microns[0009] and the amount of water absorbed is preferably 5-100 g/g, the viscosity is 1000 mPa.s [ex 7, 0109] and can be used in cosmetic compositions such as a sweat regulator and deodorant(anti perspirant)[0093].

Even though the use of the composition of Nambu as an antiperspirant is not exemplified it would be obvious within one skilled in the art to use the composition as an antiperspirant or in a method of antiperspiration because Nambu disclosed that one could use the composition as an antiperspirant.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teaches of Nambu with the composition of Daisuka because the composition of Daisuka contains a hydrophobated water-absorbing particle that is modified by silica. One would have been motivated to do so because the silicone-modified water absorbing particle of Nambu comprise a silicone compound having at least one kind of functional group, where upon absorption of water exhibit a significant reduction in sticky feeling and gel blocking attributable to the fusing

Art Unit: 1611

ability of the surfaces of the polymer particles and when used in cosmetics, the polymer particles have preferable feeling in use.[0100]

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHYAM NATHAN whose telephone number is (571)270-5753. The examiner can normally be reached on Mon-Thurs 8:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN

/Andrew D Kosar/  
Primary Examiner, Art Unit 1654